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OFFICE OF PETITIONS

In re Application of	:	
Clifford Harrison	:	
Application No. 08/919,450	:	DECISION DISMISSING
Filed: August 28, 1997	:	PETITION UNDER § 1.48(a)
Attorney Docket No. 018972.0441	:	and § 1.183
Title: SYSTEM AND METHOD FOR	:	
COMPUTER-AIDED TECHNICIAN DISPATCH	:	
AND COMMUNICATION	:	

This is a decision on the "PETITION UNDER 37 CFR 1.47 AND 37 CFR 1.183 AND DECLARATION OF FACTS IN SUPPORT THEREOF," filed May 14, 2004.

The above-identified application was filed on August 28, 1997. Clifford Harrison was named as sole inventor. On May 14, 2004, the instant request under § 1.48(a) was filed to amend the inventorship to add joint inventors, Emery Weber and Phillip Bush. § 1.48(a) requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(I); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

The petition as filed May 14, 2004 clearly satisfies requirements (1), (4) and (5). The petition specifically requests the addition of Weber and Bush as inventors, and includes a check for the processing fee. Further, petitioner encloses a written consent of assignee, and a 3.73(b) statement.

However, as to requirements (2) and (3), the petition does not include a statement from added inventor Weber and the declaration submitted is not signed by inventors Harrison and Weber.

§ 1.48(a) requires a statement from each inventor being added or deleted that the inventorship error occurred without deceptive intention. The statement need not be a verified statement (see MPEP § 605). On very infrequent occasions, the requirements of 37 CFR 1.48(a) have been waived upon the filing of a request and fee under 37 CFR 1.183 (along with the request and fee under 37 CFR 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. In re Cooper, 230 USPQ 638, 639 (Dep. Assist. Comm'r Pat. 1986). However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. In re Hardee, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). As 37 CFR 1.48(a) is intended as a simple procedural remedy and does not represent a substantive determination as to inventorship, issues relating to the inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for consideration in determining whether the record unequivocally supports the correction sought¹.

Thus, as to requirements (2) and (3), petitioner's request is being treated as a petition for waiver of the requirements 1) for a statement from the person being added as an inventor that the error in inventorship occurred without deceptive intention on his or her part and 2) that each of the actual inventors reexecute the declaration. Receipt of the fee (\$390) for such consideration is acknowledged (\$260 check and \$130 charged to Deposit Account No. 50-2428, as authorized²).

Unfortunately, petitioner has not met the requirements for waiver. Petitioner has not shown that inventor Weber cannot be reached or found, after diligent efforts, to sign the statement

¹ An available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. A request under 37 CFR 1.48(a) would not then be required in the newly filed application as no correction would be needed. Furthermore, a request under 37 CFR 1.48(a) would also not be required in the prior application that was refiled, since the prior application will be abandoned. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications. (Note: a sole-to-sole correction would not obtain benefit under 35 U.S.C. 120).

² See MPEP 201.03 Where waiver under 37 CFR 1.183 is requested in relation to a requirement under 37 CFR 1.48(a), a processing fee under 37 CFR 1.48(a) and a petition fee under 37 CFR 1.183 are required. Similarly, where in addition to a request under 37 CFR 1.48, two petitions under 37 CFR 1.183 are presented, e.g., one requesting waiver of a requirement under 37 CFR 1.48 and the other requesting waiver of the reexecution of an oath or declaration under 37 CFR 1.64, three fees are required (one for the request filed under 37 CFR 1.48 and two for the petitions filed under 37 CFR 1.183).

or to execute the declaration. Nor has petitioner shown that inventor Harrison cannot be found or reached after diligent effort to reexecute the declaration. The attempts shown to locate inventors Emery Weber and Clifford Harrison are not sufficient to show diligent effort. Petitioner has provided copies of Internet search results for the former phone numbers and addresses of the inventors (reverse searches for phone numbers and addresses) and a search by email address. However, there does not appear to be evidence of a search query by inventor name. Nor is there evidence of an attempt to determine the inventors forwarding address from the postal service or through public records, and to send the application papers to such addresses for consideration by the inventors. See MPEP 409.03(d).

In fact, a search of the EZFIND Combined Person Locator Nationwide available at www.lexis.com reveals possible addresses where both inventors Weber and Harrison can be reached. Specifically, the results indicate that a Emery James formerly of 17618 Hoyt Pl, Parker CO 80134-7552, resides at 9400 E. Iliff Avenue 413, Denver CO 80231. Likewise, the results indicate that a Clifford Harrison formerly of 240 Kearney Street, Denver CO 80220-5987, has resided at 7100 Evans Avenue, Denver CO 80224-2450. Accordingly, further efforts are warranted to reach and/or locate the inventors at those addresses.

If further attempts to contact the inventors at the above addresses or to obtain forwarding addresses or to locate the non-signing inventor by other means such as through E-mail, telephone, or the Internet continue to fail, then applicant will have provided the necessary proof required under 37 CFR 1.47 that the inventor cannot be reached. Details of the efforts to locate the non-signing inventors should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details. Applicant should submit documentary evidence such as the results of any mailings to the above-addresses and the results of any further E-mail or Internet search.

Of course, if the inventors are located, then a showing of presentation to them of the application papers and their subsequent refusal is required for waiver.

In view thereof, the petition under 37 CFR 1.183 and thus, 1.48(a) must be **DISMISSED**.

Any request for reconsideration should be filed within **TWO MONTHS** of the date of this decision to be considered timely. 37 CFR 1.181(f).

Further correspondence with respect to this decision should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

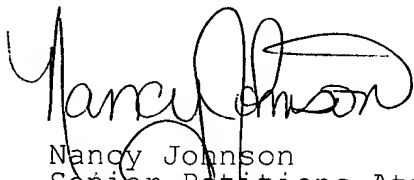
By FAX: (703) 872-9306

ATTN: NANCY JOHNSON
SENIOR PETITIONS ATTORNEY

By hand: Effective June 5, 2004, patent correspondence delivered by hand or delivery services, other than the USPS, to the Customer Window must be addressed as follows:

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Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309 (or effective September 28, 2004 at (571) 272-3282).

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is stylized with a large, looping "N" and a cursive "Johnson".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions